

REMARKS

Claims 1 – 36 remain in the application and stand finally rejected. A proposed amendment to claims 1, 16, 21, 27 and 29 is offered herein. The Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

A proposed amendment is offered herein amending claim 1 to indicate that “on-demand hand-over overrides” includes both “halting hand-overs and forcing hand-overs” which is neither shown nor suggested by any reference of record. The amendment to claims 1, 16 and 29 is supported in the specification on page 4, lines 17 – 20. Claim 21 is amended to recite the step of pre-selecting the set of target devices prior to automatic detection. The second device is selected from this pre-selected group. This is supported in the specification, e.g., on page 4, lines 10 – 13, and is neither shown nor suggested by any reference of record. Claim 27 is amended grammatically. No new matter has been added. Entry of the amendment and consideration of the claims as amended is respectfully requested.

Claims 1 – 15, 19 – 25, 27 – 32, 35 and 36 are finally rejected under 35 USC §102(b) as being unpatentable over U.S. Patent No. 6,327,470 to Ostling for substantially the same reasons as set forth for claim 20 in the prior Office action. Claims 33 and 34 are finally rejected under 35 USC §103(a) as being unpatentable over Ostling in view of Official Notice. Since published U.S. Patent Application No. 2002/0085516 to Bridgelall did not teach “hand-over overrides” as previously recited in claim 20 and previously included in claim 1, claims 1 – 19, 25 – 32 and 36 are finally rejected under 35 USC §103(a) as being unpatentable over Bridgelall in view of Ostling for substantially the same reasons as set forth in the prior Office action in combination with the rationale for rejecting claim 20 over Ostling.

As previously noted Ostling teaches a dual mode mobile station that includes a hand-over application 302 managing the hand-overs. *See, e.g.*, col. 3, line 54 – col. 4, line 31. Accordingly, there is no reason for Ostling to teach or suggest defining a set of target devices

before the step of automatically detecting as proposed amended claim 21 recites. Ostling teaches handing over between modes of the same Ostling dual mode mobile station. Thus, there is no set of target devices from which to select. Therefore, Ostling neither teaches nor suggests the present invention as recited in proposed amended claim 21. Neither is this taught or suggested by Bridgelall. Therefore, proposed amended claim 21 is patentable over all references of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claim 21 over Ostling under 35 U.S.C. §102(b) is respectfully requested.

Furthermore, in one Ostling embodiment, the dual mode mobile station can include a “‘handover’ button 410, which the subscriber presses to manually initiate the handover.” Col. 4, line 65 – col. 5, line 1. So, the Ostling

dual mode phone 400 can send a signal strength warning tone to the subscriber, indicating that the subscriber is leaving the fixed mode coverage area 308, which would **allow the subscriber** to either press the ‘handover’ button 410 and initiate the call transfer, **return** to the **fixed mode** coverage area 308, **or disconnect** the call before the subscriber leaves the fixed mode coverage area 308.

Col. 5, lines 1 – 7 (emphasis added) Providing a warning tone at the threshold and allowing someone to manually initiate a handover, physically move back into a coverage area or, disconnect, is quite different than halting a handover or performing hand-over on-demand prior to reaching the hand-over threshold as proposed amended claim 1 (and similarly in 16 and 29) recites. Therefore, Ostling does not teach or suggest the present invention as recited in proposed amended claims 1, 16 and 29. Neither is there a suggestion anywhere in Ostling or Bridgelall to allow the user to halt the handover. Therefore, proposed amended claims 1, 16 and 29 are patentable over all references of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1, 16 and 29 over Ostling under 35 U.S.C. §102(b) and, over the combination of Ostling with Bridgelall under 35 U.S.C. §103(a) is respectfully requested.

Furthermore, since dependent claims include all of the differences with the references as the claims from which they depend, claims 2 – 15, 17 – 20, 22 – 28 and 30 – 36, which depend from claims 1 or 29, respectively, are patentable over Ostling. Reconsideration and withdrawal

of the final rejection of claims 2 – 15, 17 – 20, 22 – 28 and 30 – 36, under 35 U.S.C. §§102(b) and 103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance both for the proposed amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner, enter the amendment, reconsider and withdraw the final rejection of claims 1 – 36 under 35 U.S.C. §§102(b) and 103(a) and allow the application to issue.

The applicants note that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.
(emphasis added.)

The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

August 29, 2006

(Date)

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